

REMARKS

Each paragraph of these Remarks responds to the corresponding paragraph of the Office Action mailed March 8, 2005.

1. The Applicant acknowledges that the indicated allowability has been withdrawn.
2. The Applicant acknowledges that the amendments filed on June 14, 2004 and November 5, 2004 have been entered.
3. The Examiner has rejected claims 9 and 28 under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent No. 5,287,976 issued to Mayer et al. ("Mayer Reference").

With regard to claim 9, the Examiner states that the Mayer Reference discloses all elements of claim 9 except that "Mayer et al. does not expressly disclose the second print head." With regard to the second print head, the Examiner states that "it would have been obvious to a person having ordinary skill in the art at the time the invention to add the additional print head to the system of Mayer et al. for the purpose of printing the identifier information on the publication faster and more efficiently."

With regard to claim 28, the Examiner again asserts that "Mayer et al. does not expressly disclose the second print head" but that "it would have been obvious to a person having ordinary skill in the art at the time the invention to add the additional print head to the system of Mayer et al. for the purpose of printing the identifier information on the publication faster and more efficiently."

The Applicant respectfully traverses the Examiner's rejection of claims 9 and 28 and asserts that these claims are not rendered obvious by the Mayer Reference for the following reasons.

A. Summary Of Response To Paragraph 3

With regard to claim 9, the Mayer Reference does not render claim 9 obvious because the Mayer Reference does not teach or suggest (1) the sortation device of claim 9 that “sorts...by a mail rate.” The Mayer Reference specifically teaches that the “diverter” (element 60 of FIG. 5) of that patent is used to divert defective books or separator books, not for sorting by mail rates; or (2) any print heads at the “co-mailer” as claimed in claim 9. The Mayer Reference only has a printer at the bindery so mail rates must be determined at the bindery rather than at the co-mailer which does not take full advantage of volume postage discounts.

With regard to claim 28, the Mayer Reference does not render claim 28 obvious because the Mayer Reference does not teach or suggest any print heads at the co-mailer. The bindery of the Mayer Reference places the mail rate on the publications and has no print heads at the co-mailer and therefore mail rates must be determined at the bindery rather than at the co-mailer which does not take full advantage of volume postage discounts.

B. The Mayer Reference Does Not Teach Or Suggest A “Printing Device” At The Co-Mailer That “Places The Mail Rate” On Each Publication

Claims 9 and 28 call for a print head for “printing” an “identifier information” (claim 9) and a “mail rate” (claim 28) at the co-mailer (not the bindery) after the publications have been merged. Since the mail rate is determined at the co-mailer when a number of publications are received by the co-mailer to be merged, the co-mailer is able to “print[] the mail rate” by placing as many publications into the merge stream in a sequence that maximizes the volume of publications sent to a common zip code, carrier route or enhanced carrier route, thereby minimizing postal rates that are volume dependent. Since up to 30 binderies, in one

embodiment, can send up to 30 different publications to the co-mailer (Specification, page 15, lines 8-13), the co-mailer, not the bindery, can print a mail rate determined on the volume of publications going to similar locations from all 30 publications.

This is unlike the Mayer Reference where the only mail rate determination is done at or before the bindery line and therefore the mail rate must be determined and printed at the bindery before merging any publications (Mayer Reference, Col. 6, lines 25-31). There is no “print head” at the co-mailer of the Mayer Reference, so the mail rate is only determined at the bindery and volume discounts cannot be maximize in the teachings of the Mayer Reference. Therefore, even if there are publications from other binderies with the same common zip code, carrier route or enhanced carrier route, the Mayer Reference cannot lower the mail rate at the co-mailer since there is no further printing capability at the co-mailer in the Mayer Reference. Accordingly, these independent claims, and the remaining dependent claims, are patentable over the Mayer Reference.

C. The Mayer Reference Does Not Teach Or Suggest A “Sortation Device” That “Sorts [The Publications] By The Mail Rate”

Independent claim 9 calls for a “sortation device that...sorts each of the plurality of diverse publications by the mail rate” The sortation device receives the plurality of diverse publications from a merge stream and then sorts each of the diverse publications by a mail rate.

The Examiner cites element 60 (FIG. 5) of the Mayer Reference as teaching the “sortation device” of claim 9. The Mayer Reference specifically shows a “diverter 60” in FIG. 5. The specification describes the diverter as shown below to have the function of removing unwanted books by “diverting” these books from the desired books:

magnetic tape. In addition, means are provided along the conveyor to detect defective books which are removed by a diverter operated by the programmable controller.

Mayer Reference, Col. 1, lines 22-25.

ally at 68. In the event of normal processing, the copies 30 of the publication are delivered to a mailing station and the zip code separator books 62 can be removed by utilizing a diverter 70 provided downstream of the switching device 66 in the illustrated embodiment.

Mayer Reference, Col. 9, lines 30-34.

There is no teaching or suggestion in the Mayer Reference that the diverter 60 (i) “sorts”, or (ii) sorts by a mail rate, after receiving the publications from a merge stream.

The Examiner stated in a prior Office Action that “[i] herently, the sortation of device (60) of Mayer must sort each of the plurality of diverse publications by the above cited mail rate for sorting to maximize postal discounts.” However, the Mayer Reference specifically describes the diverting function as one of “remov[ing]” the “zip code separator books 62” or “defective books”, not sorting by mail rate. Mayer Reference, Col. 9, lines 30-34. Without any description as to the function or purpose of the diverter 60 other than “removing” publications, no *prima facie* showing of anticipation or obviousness has been made for “sorting by mail rate.” Allowance of claim 9 on this basis is therefore respectfully requested.

Should the Examiner maintain this rejection, the Applicant respectfully requests that the Examiner specifically show where the diverter 60 is shown to “sort” after merging the publications on the co-mailing line 28. M.P.E.P. §2131.

D. Claim 9 Has Been Amended To Remove “For” To Show “Use”

Claim 9 has been amended to change (i) “sortation device for receiving...and sorting” to “sortation device that receives...and sorts”; and (ii) “merge stream for merging” to “merge stream that merges,” both to clarify that claim 9 is not “intended for use” but actually used. Similar amendments have been made to claims 13-15 and 18.

For the reasons provided above, claims 9 and 28 are not obvious over the Mayer Reference. Allowance is respectfully requested.

4. The Examiner has rejected claim 13 under 35 U.S.C. § 103(a) as unpatentable over the Mayer Reference in view of Delfer (U.S. Patent No. 5,264,665) (“Delfer Reference”). The Examiner states that the Mayer Reference discloses all the elements of claim 13 except that “Mayer et al. does not expressly show the system including a thickness measurement device and scale.” The Examiner then states that the Delfer Reference “teaches utilizing the thickness measurement device and scale (30 in Fig. 1A) for optimizing mail discount rates.” The Examiner then concludes that “it would have been obvious to a person having ordinary skill in the art at the time the invention to employ the scale and thickness gage by the system, as taught by Delfer, III, for the purposes of optimizing the postal discount for the mailing.”

The Applicant respectfully traverses the Examiner’s determination of obviousness of claim 13 for the following reasons. First, the “sortation device” of claim 13 is not taught or suggested in neither the Mayer Reference nor the Delfer Reference for the reasons explained above with regard to claim 9. In short, the diverter 60 of FIG. 5 in the Mayer Reference is clearly not a “sortation device” but rather a diverter to separate defective books as set forth in the Mayer Reference. (Col. 1, lines 22-25; Col. 9, lines 30-34). Second, the Examiner has not established a *prima facie* case of obviousness since there has been shown no showing by the

Examiner of a suggestion or motivation in the references themselves, or in the knowledge generally available at the time of the invention, to combine the references. M.P.E.P. § 2143. Without this showing, it is improper for the Examiner to use hindsight to combine these two references.

For the reasons provided above, claim 13 is not obvious over the Mayer Reference in view of the Delfer Reference. Allowance is respectfully requested.

5. The Examiner has rejected claims 14 and 15 under 35 U.S.C. § 103(a) as unpatentable over the Mayer Reference in view of Humes et al. (U.S. Patent No. 5,377,120) (“Humes Reference”). The Examiner states that the Mayer Reference discloses all the elements of claims 14 and 15 except that “Mayer et al. does not expressly show the system including a co-mailer merge and sequence module” as claimed. The Examiner then states that the Humes Reference teaches the “co-mailer merge and sequence module” of claims 14 and 15 and, when combined with the Mayer Reference, renders these claims obvious.

The Applicant respectfully traverses the Examiner’s determination of obviousness of claims 14 and 15 for the following reasons. First, the “sortation device” of claims 14 and 15 is not taught or suggested in the Mayer Reference for the reasons explained above with regard to claim 9. In short, the diverter 60 of FIG. 5 in the Mayer Reference is clearly not a “sortation device” but rather a diverter to separate defective books as set forth in the Mayer Reference. (Col. 1, lines 22-25; Col. 9, lines 30-34). Second, the Examiner has not established a *prima facie* case of obviousness since there has been shown no showing by the Examiner of a suggestion or motivation in the references themselves, or in the knowledge generally available at the time of the invention, to combine the references. M.P.E.P. § 2143. Specifically, there has been no showing that one of ordinary skill in the art viewing either the Mayer Reference or the Humes

Reference would find a motivation or suggestion in either reference to combine the references. Without this showing, it is improper for the Examiner to use hindsight to combine these two references.

For the reasons provided above, claims 14 and 15 are not obvious over the Mayer Reference in view of the Humes Reference. Allowance is respectfully requested.

6. The Examiner has rejected claim 21 under 35 U.S.C. § 103(a) as unpatentable over the Mayer Reference in view of the Humes Reference and the Delfer Reference. The Examiner states that the Mayer Reference discloses all the elements of claim 21 except that “Mayer et al. does not expressly show the method including measuring a thickness and weight of each of the plurality of publications” as claimed. The Examiner then states that the Delfer Reference teaches “utilizing the thickness measurement device and scale (30 in Fig. 1A) for optimizing the mailing discount rates” of claim 21. The Examiner also states that remaining steps in the “modified method of Mayer et al.” is found in the Humes Reference. The Examiner then combines all three references to conclude that claim 21 is obvious.

The Applicant respectfully traverses the Examiner’s determination of obviousness of claim 21 for the following reasons. First, the “sorting step” of claim 14 is not taught or suggested in the Mayer Reference for the reasons explained above with regard to claim 9. In short, the diverter 60 of FIG. 5 in the Mayer Reference is clearly not a “sortation device” used for “sorting,” but rather a diverter to separate defective books as set forth in the Mayer Reference. (Col. 1, lines 22-25; Col. 9, lines 30-34). Second, the Examiner has not established a *prima facie* case of obviousness since there has been shown no showing by the Examiner of a suggestion or motivation in the references themselves, or in the knowledge generally available at the time of the invention, to combine the references. M.P.E.P. § 2143. Specifically, there has

been no showing that one of ordinary skill in the art viewing either the Mayer Reference or the Humes Reference would find a motivation or suggestion in either reference to combine the references. Without this showing, it is improper for the Examiner to use hindsight to combine these three references.

7. The Applicant acknowledges that the Examiner has allowed claims 22 and 23.

Claim 18

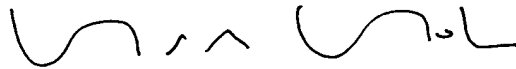
The Examiner rejected claim 18 in the “Office Action Summary,” but provided no explanation whatsoever in the “Detailed Action” as to the basis for that rejection or any references relied upon for that rejection. As clearly required by M.P.E.P. §706 and 37 C.F.R. §1.104(c)(2), the Examiner’s rejection must be “clearly explained...”. As a result, Applicant is unable to respond to the general rejection of claim 18. Should the Examiner continue this rejection, a detailed action on this rejection is respectfully requested in a non-final action to allow the Applicant to formally respond.

Conclusion

For the reasons provided above, allowance of all pending claims is respectfully requested.

No fee is believed due with this communication. If any fees are in fact due, please charge any amount due (or credit any overpayment) to Deposit Account No. 13-0019.

Respectfully submitted,



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